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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,227	08/27/2001	Sci-Yu Chen	DEX-0230	4313
26259	7590	06/30/2004		
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			EXAMINER BLANCHARD, DAVID J	
			ART UNIT	PAPER NUMBER

1642

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/940,227

Applicant(s)

CHEN ET AL.

Examiner

David J Blanchard

Art Unit

1642

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

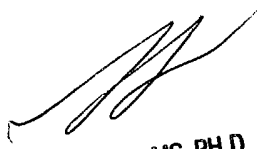
Claim(s) rejected: 9-10 and 17.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: Newly added claims 18-22 add limitations that would require further consideration and search and amended claim 9 adds the limitation that the nucleic acid is differentially expressed, which would require further consideration and search.

Continuation of 5. does NOT place the application in condition for allowance because: If if Applicant cancelled newly added claims 18-22, the rejection of claims 9-10 and 17 under 35 U.S.C. 112, first paragraph, enablement and written description is maintained. Applicant argues that the skilled artisan would know how to make and use the claimed antibodies in view of the instant disclosure and the antibodies could be used to identify clones expressing LSG polypeptides or to purify LSG polypeptides. Applicant also argues that the instantly claimed antibodies could be used for ELISAs. In response to these arguments, there is still no indication that the polypeptide encoded by SEQ ID NO:15 or the polypeptide of SEQ ID NO:83 is actually expressed in cancer cells. Applicant is relying upon increased levels of nucleic acid expression and asserting that polypeptide expression follows. In contrast, the art of record (Fu et al, Powell et al, Vellejo et al and Jang et al; see Office Action mailed 9/23/2003) demonstrates that the analysis of levels of polynucleotide transcripts cannot be relied upon to anticipate levels of protein expression and Applicant still has not addressed this art of record. It is irrelevant that the nucleic acid is differentially expressed until objective evidence is provided contrary to the art of record establishing that the encoded polypeptide is expressed and detectable (e.g. ELISA) in cancer cells. Applicant is reminded that the enablement of the antibody depends upon whether or not the polypeptide it binds has enablement. With respect to the written description rejection, Applicant's claims remain drawn to differential nucleic acid expression in any cancer cells (see claim 9). Table 2 at pages 141-143 shows that SEQ ID NO:15 is not expressed in kidney, liver, thyroid, skin, testis and mammary cancer cells. Therefore, the specification does not support the broad recitation that SEQ ID NO:15 is differentially expressed in cancer cells.. DB

  
LARRY R. HELMS, PH.D  
PRIMARY EXAMINER